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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,754	09/29/2003	Ifedayo Udiani	39576	1464
59241 7590 04/30/2009 LATIMER, MAYBERRY & MATTHEWS IP LAW, LLP 13873 PARK CENTER ROAD SUITE 106 HERNDON, VA 20171				
EXAMINER				
GREGG, MARY M				
ART UNIT		PAPER NUMBER		
3694				
NOTIFICATION DATE		DELIVERY MODE		
04/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JEN.CORTESE@LATIMERIP.COM

Office Action Summary

Application No.

10/673,754

Applicant(s)

UDIANI, IFEDAYO

Examiner

MARY GREGG

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above claim(s) 32-34 and 36-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32-34 and 36-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to communications received February 13, 2009. Claims 1-28 have been canceled. New claims 29-44 have been added. Therefore, claims 29-44 are pending and addressed below.

Election/Restrictions

2. Newly submitted claims 30-34 and 36-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The newly submitted claims are patently distinct from the originally filed claimed invention. The newly submitted claims are related to the originally filed claims as a combination /subcombination. It is well settled that the subcombination is patently distinct if the subcombination has separate utility. Here the newly cited claims 30-31 and 34 claims a method for providing electronic online transactions by printing sets of standard of value on paper or plastic. Claims 32-34 and 36-44 cite a method for logging on an online user to a third party payment provider. These features are distinct from the previously elected claimed invention of claims 5-28, 29 and 35 which pertains to an online method of payment utilizing a pre-paid smart card wherein the users information is confidential.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-34 and 36-44 are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendments/Arguments

3. Applicant's arguments have been fully considered but are moot as the applicant's arguments are directed toward non-elected claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to Claim 29:

Claim 29 cites in the preamble as being directed toward a system, however, the body of the claim cites the system comprising: "shopper" and "merchants". A claim is defined by its structural elements and corresponding functionality. The positive recitation of a human renders the claim indefinite as the structural elements attributed to a human are not ascertainable within the context of the claim read in light of the specification.

In reference to Claim 35:

Claim 35 depends upon claim 29 and contains the same deficiencies cited above, therefore claim 35 is also rejected under 35 USC 112, 2nd paragraph.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 29 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to Claim 29:

Claim 29 cites in the preamble as being directed toward a system, however, the body of the claim cites the system comprising: "shopper" and "merchants", which in non-statutory subject matter. A claim is defined by its structural elements and corresponding functionality. The positive recitation of a human renders the claim non-statutory, see MPEP 2105.

In reference to Claim 35:

Claim 35 depends upon claim 29 and does not cure the deficiencies cited above, therefore claim 35 is also rejected under 35 USC 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pub No. 2002/0055911 A1 by Guerreri (Gue).

In reference to Claim 29:

(new) An e-commerce system for payments over the internet comprising:

- a. at least one shopper capable of purchasing goods or services online ((Gue) abstract, para 0016 lines 2-10);
- b. at least one merchant capable of selling goods or services online ((Gue) para 0005, para 0006, para 0007; wherein the prior art teaches old and well known); and
- c. a third party payment solutions merchant capable of completing an online transaction between said shopper and said merchant without said shopper using a credit card, debit card, or bank account for said online transaction ((Gue) abstract, para 0016, para 0022).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub No. 2002/0055911 A1 by Guerreri (Gue) as applied to claim 35 above, and further in view of US Pub No. 2002/0120537 A1 by Morea et al. (Mor).

In reference to Claim 35:

Gue teaches:

(new) The payment system of claim 29 (see rejection of claim 29 above), wherein said online transaction between said online shopper and said online merchant is electronically recorded ...

Gue does not explicitly teach:

...in real time ((Gue) para 0021)

Mor teaches:

...in real time ((Mor) FIG. 1, FIG. 2, FIG. 4; para 0006, para 0070, para 0071)

Both Gue and Mor are directed toward online transactions. Mor teaches the online market place needs to create and maintain trusted services and products, which would include real-time authorization. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention apply a known technique to a known device (method, or product) ready for improvement to yield predictable results.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY GREGG whose telephone number is (571)270-5050. The examiner can normally be reached on 4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 5712726712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/673,754
Art Unit: 3694

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/M. G./
Examiner, Art Unit 3694

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694